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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,584	07/29/2003	Yannis Labrou	1634.1002	4134

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EXAMINER

LEVINE, ADAM L

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/628,584

Applicant(s)

LABROU ET AL.

Examiner

Adam Levine

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters 102, 104, 105, and 136 in Figures 1-4 have been used to designate different parts with the same numbers. This may be due to discrepancy with part names used in the Brief Description. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The use of the trademark BLACKBERRY has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

### ***Claim Objections***

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim that depends from a dependent claim should not be separated by any claim that does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n). It is noted that dependent claim 19 depends from dependent claim 15 but is separated therefrom by claims 16-18. Claims 16-18 do not depend from dependent claim 15. Claim 21 depends from dependent claim 14 but is separated therefrom by claims 15-20. Claims 15-20 do not depend from claim 14. Multiple dependent claims 28, 29, and 30 depend from dependent claims 14, 15, and 21 but are separated therefrom by claims 16-18 and 20. Claims 16-18 and 20 do not depend from claims 14, 15, or 21. Multiple dependent claim 31 depends from dependent claims 22-27 but is separated from them by claims 28-30. Claims 28-30 do not depend from any of claims 22-27.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “discovering comprising automatically scanning the wireless network,” does not reasonably provide enablement for “manually discovering one or more merchant devices.” The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The specification is not enabling for “manually discovering one or more merchant devices” because in the context of the disclosure of the method, how the one or more merchant devices would be manually discovered is not described in such a way that would enable a person of ordinary skill in the art to understand the way the manual discovery of the one or more merchant devices is accomplished within the context of using the method.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3,4, 10, 19 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the Secure Transaction Protocol" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the paid-for services" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the steps preceding the verification of the merchant device by the secure transaction server. By way of further explanation, it is assumed that the steps of claim 9 do not pass through the secure transaction server, it is therefore unclear exactly what steps are taking place to have the secure transaction server verify the merchant device before transmitting the purchase order to the consumer device. It is also assumed that the verification of the merchant device is the verification of the identity of the merchant described in claim 1, however it is not clear that both the verification of the merchant device and the verification of the merchant are the same. The steps clarifying this relationship are missing throughout the dependent claims.

Claim 19 recites the limitation "the directing of payment" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is also unclear to what "directing of payment" refers, i.e., whether it refers to the vector of travel of the payment, or merely the instruction to make payment.

Claim 21 recites the limitation "the direction of payment" in line 1. There is insufficient antecedent basis for this limitation in the claim. It is also unclear to what

"direction of payment" refers, i.e., whether it refers to the vector of travel of the payment, or merely the instruction to make payment.

Claim 21 recites the limitation "the encrypted consumer token" in lines 23-24. There is insufficient antecedent basis for this limitation in the claim. It is assumed that this is intended to refer to the encrypted version of the token sent by the consumer to the merchant.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**3. Claims 1-28 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldstein (US Pat.No. 6,957,334).**

Goldstein teaches all the limitations of claims 1-28 and 30. For example, Goldstein teaches a method for conducting a purchasing agreement for goods and services between a consumer and a merchant through a trusted third party and using a wireless network. Goldstein further discloses:

- generating by the consumer a first view of the agreement: transmitting the first view of the agreement to the third party, generating independently by the

merchant a second view of the agreement, transmitting the second view of the agreement to the third party, receiving by the third party comprising a Secure Transaction Server the consumer view of the agreement and the merchant view of the agreement, verifying identities of the merchant and the consumer and that the details of the independently generated views of the agreements are consistent (see at least abstract, column 2 line 46 – column 3 line 3, lines 45-58); taking action to execute the purchasing agreement if the conditions are satisfied (see at least column 8 lines 26-50)

- purchasing agreement includes: ordering of and paying for goods or services, transaction comprises purchase of physical goods (see at least abstract. Please note: commercial transactions involve the ordering of and paying for goods or services)
- conducting purchases using local wireless communication: between a consumer operated mobile device and a merchant operated device and a Secure transaction Server device comprising the trusted third party, and parts of the messages communicated between the devices and the secure transaction server are encrypted using the Secure Transaction Protocol (see at least column 2 line 9- column 3 line 32, column 5 lines 17-41); discovering by the consumer device the merchant device via the network, connecting by the consumer device to the merchant device via the network, obtaining by the consumer a list of available merchants and contact information to be displayed on his device selecting from the consumer's device the merchant for which a purchase transaction is desired



(see at least figs. 1-3, column 2 lines 9-18, 46-60; column 3 lines 45-50); selecting by the consumer using the consumer device the goods and services to be purchased, selecting one of the goods or services from a list of the goods and services of the merchant presented by the consumer device, providing inputs to the retail application through the consumer device to arrive at the intended list of purchased goods and services from the selected merchant through ordering or other physical means provided by the merchant including scanning, providing, by the merchant, the accumulated purchase price of the selected goods and services, sending by the consumer an explicit generate-purchase-order to the merchant, creating by the merchant a purchase order corresponding to the items selected by the consumer and sending the purchase order to the consumer (see at least fig. 1, column 2 lines 10-25; column 3 lines 40-50, column 5 lines 17-41, column 8 lines 45-51); obtaining a purchase order from the merchant containing the transaction details such as amount and authorizing by the consumer using the consumer device payment to the merchant for the goods and services through the secure transaction server, transmitting by the consumer device a request for a purchase order for items to be purchased to the merchant device, preparing by the merchant device a purchase order with information including pricing and transmitting the purchase order to the consumer device, upon receiving the purchase order by the consumer device, authorizing by the consumer device payment for the purchase order (see at least fig. 1, column 2 lines 15-25); scanning the wireless network or manually discovering one or more

merchant devices and the consumer then selecting one of the merchant devices from a list of merchant devices presented by the consumer device, connecting the consumer device to the selected merchant device through the wireless local communication network, directing by the consumer the consumer device to establish wireless communication using the contact information of the selected merchant; and accessing by the consumer device the retail application of the merchant device (see at least figs. 1-3, column 2 lines 9-18, 46-60; column 3 lines 33-58, column 5 lines 56-60, column 7 lines 15-24)

- trusted third party returns a token: as receipt of payment that is presented by the consumer to the merchant to obtain the paid-for services at a later time, Secure Transaction Server causes a token to be sent to the consumer and the merchant as proof of payment and that can be presented when the service is activated or consumed, or goods received (see at least column 2 lines 52-60, column 4 lines 5-8); sending by the consumer a request-token request to the merchant, generating by the merchant a token and sending to the consumer representing the unvalidated payment for service (see at least column 1 lines 36-45, column 2 line 46-column 3 line 22, column 4 line 55 – column 5 line 11).
- an encrypted version of the token: sent by the consumer as acknowledgement to the merchant, requesting by the merchant a token certificate from the STS using the encrypted consumer token, generating by the STS a token certificate and transmitting a copy to the merchant, and presenting by the consumer the token to the merchant upon consumption of the service (see at least column 2 line 23-

column 3 lines 3, 33-58; column 4 lines 13-37, column 6 lines 12-60); sending by the consumer a request-authorization-with-token request to the STS containing an encrypted version of the token, authorizing by the merchant the sale by sending a request-authorization-with-token to the STS including account selection (see at least column 2 line 23-column 3 lines 3, 33-58; column 4 lines 13-37, column 6 lines 12-60)

- verifying the merchant device: by the secure transaction server before the purchase order is transmitted to the consumer device, verifying the merchant device by the secure transaction server after the purchase order is transmitted to the consumer device (see at least abstract, column 2 line 46 – column 3 line 22); creating an STS version of the PO from the merchant PO (STS-PO) and transmitting by the STS the STS-PO to the merchant, the merchant transmits the STS-PO to the consumer device so that upon receipt of the STS-PO the consumer has positive verification that the merchant is a registered merchant (see at least column 2 line 46 – column 3 line 22, column 3 line 33-column 4 line 37, column 7 line 36-column 8 line 51); issuing by the client a merchant verification transaction including the merchant information and merchant device identifier and sending the merchant verification transaction to the merchant device, forwarding by the merchant device to the STS the merchant information and the merchant device identity, verifying by the STS the merchant information and the merchant device identity with its records, returning by the STS a merchant verification response message to the merchant for forwarding to the

consumer, receiving by the consumer the message indicating whether the merchant is valid (see at least column 2 line 46 – column 3 line 22, column 3 line 33-column 4 line 37, column 7 line 36-column 8 line 51).

- indicating by the consumer intent to proceed with payment: for the purchase order via a command entered into the consumer device (see at least column 2 lines 9-42, column 3 lines 33-58); upon receiving the command and a positive result of merchant verification by the secure transaction server, the consumer device indicating the intent to authorize payment and transmitting the intent to the secure transaction server via the merchant (see at least column 2 lines 9-42, column 7 line 35 – column 8 line 4); and upon receiving a positive result of the verification by the secure transaction server, the merchant indicating the intent to authorize acceptance of payment and transmitting the consumer intent and the merchant intent to the secure transaction server (see at least abstract, column 2 line 46 – column 3 line 22).
- interacting by the secure transaction server: with a payment service to cause the transfer of funds or commitment for transfer of funds from the consumer to the merchant to occur and upon completion of the transfer of funds, transmitting by the secure transaction server, a confirmation to the consumer and the merchant (see at least column 3 line 33 – column 4 line 12)
- providing personal identification information: by the consumer to the consumer device and requesting by the consumer a preauthorization by identification information sending a request-transaction including account selection

(preauthorization) to the STS, combining the request and authorization and sending a request-authorization of the payment, by the merchant to the merchant device and issuing a request-authorization, sending a request-transaction to the STS, including account selection (see at least abstract, figs.1,3; column 1 lines 35-45, column 2 lines 9-42, column 5 line 56-column 6 line 11); responding by the STS positively to the consumer and the merchant if the identities and details of the request transaction are verified, including a listing of accounts to the consumer (see at least abstract, column 2 line 46 – column 3 line 3, column 5 line 56-column 6 line 11, column 7 line 36-column 8 line 4); authorizing, by the consumer, the payment to the STS including account selection by an authorization message, authorizing, by the merchant, the sale to the STS including account selection by an authorization message, causing, by the STS, the payment from the consumer account to the merchant account if the parties and details of the payment transaction are verified, responding, by the STS, to the merchant and the consumer with the results of payment transaction (see at least column 2 lines 8-42, column 7 line 36-column 8 line 4).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (US Pat.No. 6,957,334) in view of Official Notice (regarding merchant advertisement or directory service).**

Goldstein teaches all of the above as noted under the 102(e) rejection and teaches a) verifying consumer identity and authorization to perform transaction, b) verifying merchant identity and authority to perform transaction, c) consumer selecting merchant for contacting in order to pursue a transaction, and d) selecting merchants products or services for purchase, but does not disclose the consumer obtaining the merchant legal name and address from a merchant device advertisement or a directory service. The examiner takes the position that it is old and well known in the art for a consumer to obtain a merchant legal name and address from a merchant device advertisement or a directory service. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method of Goldstein to disclose a consumer obtaining a merchant legal name and address from a merchant device advertisement or a directory service as taught by Official Notice, in order to allow the consumer to select a merchant and thereby facilitate the initiation of the commercial transaction disclosed by the system and method.

**5. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein (US Pat.No. 6,957,334) in view of Official Notice (art recognized equivalents).**

Goldstein teaches all of the above as noted under the 102(e) rejection and teaches a) identifying products or services ordered through generation of purchase orders, b) transmission of purchase orders to a trusted third party authenticator, c) generation of tokens to indicate authorization of purchase, d) merchant using the token to verify the consumer purchase and making delivery of the purchased item, and e) encrypting the token for added security, but does not disclose converting by the consumer device the token to a barcode and displaying the token represented as a barcode on its display, scanning by the merchant device the barcode, converting the barcode to a token and then checking the token. It would have been obvious to one having ordinary skill in the art at the time of the invention to use either a token or a barcode interchangeably to identify a person, item, or an authorization, since the examiner takes Official Notice of the equivalence of a token and a barcode for their use in the art of identifying a person, item, or authorization, and the selection of any or all of the known equivalents to a token or barcode would be within the level of ordinary skill in the art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine  
Patent Examiner  
September 19, 2006



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